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No. 04-293

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

HONEYWELL INTERNATIONAL INC.
and HONEYWELL INTELLECTUAL PROPERTIES INC.,

Petitioners,

v.

HAMILTON SUNDSTRAND CORPORATION,

Respondent.

On Petition for Writ Of Certiorari To The United States Court of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Prosecution history estoppel prevents a patentee from invoking the doctrine of equivalents to recapture subject matter surrendered during prosecution of the patent. Hence, the estoppel rule ensures that claims are interpreted by reference to those "that have been cancelled or rejected." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733 (2002) (citation omitted). The decision below addressed a narrow question concerning a particular action in the prosecution of patent applications: whether a presumption of prosecution history estoppel arises when, to gain allowance of a patent, a patent applicant agrees to cancel a rejected independent claim and replace it with a narrower, previously-dependent claim. This Court in *Festo* specifically rejected the argument that no estoppel arises when an applicant "rewrite[s] a dependent claim as an independent one," explaining that estoppel does arise when an "amendment is made to secure the patent and the amendment narrows the patent's scope." *Id.* at 736. A patent applicant narrows the patent's scope when he cancels an original independent claim, after it was rejected, and replaces it with a narrower, previously-dependent claim. Hence, adhering to this Court's guidance and to every precedent that has addressed the question, the nearly unanimous *en banc* Federal Circuit held below that a presumption of estoppel arises in these circumstances.

The question presented is whether the Federal Circuit was correct in holding, in an *en banc* decision joined by 11 of the Circuit's 12 judges, that a presumption of prosecution history estoppel arises when a patent applicant narrows a patent's scope by cancelling a rejected independent claim and replacing it with a narrower, previously-dependent claim.

RULE 29.6 STATEMENT

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RESPONDENT'S BRIEF IN OPPOSITION

Hamilton Sundstrand Corporation submits this brief in opposition to the petition for a Writ of Certiorari. Hamilton Sundstrand is a maker of high technology aerospace equipment and is a member of the United Technologies Corporation family, which includes the makers of Pratt & Whitney aircraft engines, Sikorsky helicopters, Otis elevators, Carrier cooling systems and many other products. United Technologies conducts over one billion dollars' worth of research and development every year, and it holds a vast portfolio of patents that are the product of that work.

INTRODUCTION

The Federal Circuit's *en banc* decision in this case—joined by 11 of the Circuit's 12 judges—addressed a narrow question concerning a particular action in the prosecution of patent applications: whether a presumption of prosecution history estoppel arises when a patent applicant narrows a patent's scope by cancelling a rejected independent claim and replacing it with a narrower, previously-dependent claim. *Honeywell International, Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1139-44, Appendix ("App.") 13a-22a (Fed. Cir. 2004) (*en banc*). In holding that presumptive estoppel does arise here, the Federal Circuit applied this Court's precedents and express guidance on this very question, and it adhered to the Federal Circuit's own consistent line of decisions.

Honeywell addresses whether the presumption of estoppel arises in the following scenario. A patent applicant initially seeks a broad independent claim with limitations A, B and C, but this claim is rejected as obvious in light of the prior art. Instead of contesting the rejection, the applicant elects

to gain allowance by narrowing his claim scope. He does so by cancelling the independent claim and replacing it with a narrower, previously-dependent claim that adds limitation D. Thus, the applicant surrenders the broader original claim—which only had limitations A, B and C—and settles instead for the narrower claim with limitations A, B, C and D.

In the Honeywell prosecution, the "inlet guide vane" limitation is limitation D. Honeywell originally sought independent claims that ***lacked*** the inlet guide vane limitation, but those claims were rejected as obvious under 35 U.S.C. § 103. *Honeywell*, 370 F.3d at 1137, App. 8a-10a. Honeywell could have contested the rejection. But instead, acquiescing in the rejection, it agreed to narrow its claim scope by cancelling the original independent claims and replacing them with previously-dependent claims that ***included*** the inlet guide vane limitation. *Id.* Honeywell thus gained allowance by relying on the inlet guide vane limitation to narrow the claimed subject matter and distinguish the prior art. And it surrendered any right to claims that lacked the inlet guide vane limitation.

After having won its patent by surrendering any right to claims that lacked the inlet guide vane limitation, Honeywell then brought this suit in which it asserts infringement against a Hamilton Sundstrand product that does ***not*** have what the inlet guide vane limitation specifies. This is just what prosecution history estoppel is supposed to prevent. In its *en banc* decision below, the Federal Circuit correctly held that Honeywell's narrowing of claim scope during prosecution created a presumption of estoppel with respect to the inlet guide vane limitation. The court explained:

> Under such circumstances, the surrendered subject matter is defined by the cancellation of independent claims that do not include a particular limitation and the rewriting into independent form of dependent claims that do include that limitation. Equivalents are presumptively not available with respect to that added limitation.

Id. at 1144, App. 22a. Having held that the presumption of estoppel applies to the inlet guide vane limitation—which Honeywell conceded could be satisfied only under the doctrine of equivalents—the Federal Circuit remanded for a determination of whether Honeywell can overcome the presumption under the test this Court set forth in *Festo*. *Id.*[1]

The holding here is nothing new. In *Festo*, the petitioner argued that no estoppel should arise when an applicant "rewrite[s] a dependent claim as an independent one." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002). This Court specifically rejected the argument. *Id.* Emphasizing that the proper focus is whether the amendment narrows the overall scope of the claimed subject matter, the Court explained that estoppel arises when—as here—an "amendment is made to secure the patent and the amendment narrows the patent's scope." *Id.*

Adhering to this fundamental principle, the Federal Circuit has consistently held that a presumption of estoppel

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[1] The Federal Circuit deferred ruling on Hamilton Sundstrand's separate argument that Honeywell's doctrine of equivalents claim is unsustainable on the facts, in light of the substantial differences between the Hamilton Sundstrand product and the Honeywell patent claims. *See Honeywell*, 370 F.3d at 1144, App. 22a-23a.

arises when an applicant cancels an independent claim and replaces it by rewriting a narrower dependent claim into independent form. *See Deering Precision Instruments, L.L.C. v. Vector Distribution Systems, Inc.*, 347 F.3d 1314, 1325-26 (Fed. Cir. 2003), *cert. denied*, 124 S. Ct. 1426 (2004); *Ranbaxy Pharma., Inc. v. Apotex, Inc.*, 350 F.3d 1235, 1240-41 (Fed. Cir. 2003). So, too, in *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675 (Fed. Cir. 1988), the court applied estoppel to a limitation, where an independent claim that lacked the limitation was rejected, cancelled and replaced with the previously-dependent claim that included the limitation. *Id.* at 681.

This consistent decisional law is reflected in the Chisum treatise's summary of holdings—both before and after *Festo*—that estoppel applies "when a broad claim is cancelled after rejection and a narrower claim is retained without amendment." 5A Chisum on Patents, § 18.05[2][a][ii] (citing cases). As Judge Learned Hand explained more than 60 years ago, there is "no difference between [the] situation [where the claim was amended to secure allowance] and one where as here the applicant files a limited and a broader claim at the same time and then cancels the broader one when it has been rejected." *Keith v. Charles E. Hires Co.*, 116 F.2d 46, 48 (2d Cir. 1940).

In light of this long and consistent line of authority, the holding in *Honeywell* certainly was not surprising. Indeed, Honeywell can find no decision that has addressed the facts here and held that estoppel does ***not*** apply. Nor does the lone dissenter from the decision below, Judge Newman, identify any such precedent.

Against this background, there is no reason for the Court to hear this case.

ARGUMENT

The *en banc* decision in this case was joined by an overwhelming 11 to one majority of the Federal Circuit's judges; it is grounded in the core principles of prosecution history estoppel established by this Court and is faithful to the specific guidance of this Court; and it is consistent with the unvarying line of precedent on the question at issue. Under the standards set forth in the Court's rules, there is no basis for granting certiorari.

I. The Decision Adheres To This Court's Precedents And This Court's Express Guidance On The Question Presented

Prosecution history estoppel prevents a patentee from invoking the doctrine of equivalents to attempt to "read the granted claim as the equivalent of those which were rejected." *Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42, 48 (1934). Hence, the estoppel rule requires that claims be interpreted by reference to those "that have been cancelled or rejected." *Festo*, 535 U.S. at 733 (citation omitted). When a patent examiner rejects a claim, the applicant of course can appeal the rejection. But if the applicant chooses to forgo an appeal and to accept a narrower claim instead, that is taken as a "concession that the invention as patented does not reach as far as the original claim." *Id.* at 734. "Were it otherwise, the inventor might avoid the PTO's gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent." *Id.*[2]

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[2] These core principles are old and well established. *See, e.g., Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 40 (1893) ("Having originally sought broader claims, which were rejected, and

The facts here provide a classic basis for estoppel. Honeywell originally tried to obtain independent claims that ***lacked*** the inlet guide vane limitation. *Honeywell*, 370 F.3d at 1137, App. 8a-10a. But those claims were rejected as obvious in light of the prior art. *Id.* Rather than contest the rejection, Honeywell acquiesced in it. Honeywell cancelled its original independent claims and replaced them with previously-dependent claims that ***added*** the inlet guide vane limitation. *Id.* Thus, Honeywell relied on the inlet guide vane limitation to narrow its claimed invention in order to distinguish the prior art, and it surrendered any right to claims that lacked the inlet guide vane limitation.

That presumptive estoppel arises here is mandated not only by the fundamental principles set forth above, but also by this Court's specific guidance in *Festo*. The petitioner in *Festo* maintained that estoppel could not arise when an applicant "rewrite[s] a dependent claim as an independent one." *Festo*, 535 U.S. at 736. Rejecting the argument, the Court stated that "petitioner's argument conflates the patentee's reason for making the amendment with the impact the amendment has on the subject matter." *Id.* The Court emphasized that the test is whether the applicant has narrowed the scope of the patent: "[e]stoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope." *Id.*

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having acquiesced in such rejection," the patentee cannot be allowed "to insist upon such construction of the allowed claim as would cover what had been previously rejected."); *Shepard v. Carrigan*, 116 U.S. 593, 597 (1886) (Where prosecution history demonstrated that "[w]ithout this element the patent would not have been issued," the patentee "cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent").

Here, Honeywell chose to cancel its original independent claims that lacked the inlet guide vane limitation, after those claims were rejected as obvious, and to replace them with previously-dependent claims that included the inlet guide vane limitation. Contrary to Honeywell's argument, this was not merely "cosmetic." In the words of *Festo*, Honeywell's decision plainly was "made to secure the patent" and it plainly did "narrow[ ] the patent's scope." *Id.* *See also Deering*, 347 F.3d at 1325-26 (patentee's decision to cancel an independent claim and replace it with a narrower, previously-dependent claim was not "cosmetic," but rather was a "clear surrender of the broader subject matter of the deleted original independent claim").

Notably, *Festo* held that presumptive estoppel applied to limitations that, as here, had been present from the application's outset in original dependent claims. One such limitation, in the Stoll patent, specified the use of a magnetizable composition in the sleeve. *Id.* at 728. As recited by the Federal Circuit opinion in *Festo*, "[o]riginal claim 1 did not recite a magnetizable sleeve, although this feature of the invention ***was recited in original dependent claim 8***. In response to the first office action, Festo replaced original claim 1 with a claim reciting a magnetizable sleeve and canceled claim 8." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 588 (Fed. Cir. 2000) (*en banc*), *vacated and remanded*, 535 U.S. 722 (2002) (emphasis supplied). Thus, as here, the applicant narrowed claim scope by cancelling an original independent claim that ***lacked*** a limitation that was present in an original dependent claim—the magnetizable sleeve—and replacing it with a claim that ***included*** the limitation. This Court ruled that this narrowing of claim scope gave rise to

presumptive estoppel with respect to the magnetizable sleeve limitation. *Festo*, 535 U.S. at 736-37.

We note that the United States' *amicus* brief in *Festo* referred to the district court's decision in this case and stated that estoppel should not arise when an applicant "amend[s] by rewriting a dependent claim as an independent claim." 2001 WL 1025650 at *16. This limited statement does not address the full set of facts here, because Honeywell did more than merely rewrite a dependent claim into independent form. The key to Honeywell's surrender of claim scope is that it ***cancelled*** a broad original independent claim after that claim was rejected as obvious, and it settled instead for the narrower, previously-dependent claim. As this Court made clear in *Festo*, such a narrowing of claim scope gives rise to a presumptive estoppel. *Festo*, 535 U.S. at 736-37.

II. The Decision Agrees With Every Precedent That Has Addressed The Question Presented

This is not the first time the Federal Circuit has addressed the question at issue. Each time, the answer has been the same.

In *Deering*, the Federal Circuit held that cancelling a broader independent claim and replacing it with a dependent claim rewritten into independent form was a "clear surrender of the broader subject matter" that presumptively barred application of the doctrine of equivalents. 347 F.3d at 1325. There the patentee cancelled original independent claim 1, after it was rejected as obvious, and replaced it by rewriting into independent form a previously-dependent claim that added a limitation referred to as the "zero position limitation." *Id.* at 1318-19. Rejecting the argument

that this amendment was merely "cosmetic," the court held that "the clear surrender of the broader subject matter of the deleted original independent claim presumptively" barred the patentee from arguing equivalents related to the zero position limitation. *Id.* at 1325-26. Further, while Honeywell's citation to *Deering* omits the fact, certiorari was sought in *Deering* and denied. *See* 124 S. Ct. 1426.

The holding in *Ranbaxy* was the same. There, the examiner rejected independent claim 1 as obvious and indefinite in the first office action, but indicated that dependent claims 3, 5 and 7 would be allowable if rewritten into independent form. 350 F.3d at 1238. The patentee responded by canceling claim 1 and rewriting the dependent claims into a single, new independent claim. *Id.* The *Ranbaxy* court explained that there is a presumption of estoppel if the amendment "surrendered subject matter that was originally claimed for reasons related to patentability." *Id.* at 1240 (quoting *Deering,* 347 F.3d at 1325). And it held that estoppel arose on the facts presented, because substituting the narrower rewritten claim for the broader original independent claim was a clear surrender of subject matter. *Id.* at 1241.

These holdings broke no new ground. They follow from the core purpose of prosecution history estoppel, to prevent a patentee from attempting to recapture the "subject matter surrendered as a condition of receiving the patent." *Festo*, 535 U.S. at 734. And they apply the core rule that claims are interpreted by reference to those "that have been cancelled or rejected." *Id.* at 733 (citation omitted). Judge Learned Hand explained long ago how these rules apply in this particular setting:

> We can see no difference between [the] situation [where the claim was amended to secure allowance] and one where as here the applicant files a limited and a broader claim at the same time and then cancels the broader one when it has been rejected. The theory of the "estoppel," as it is called, is that, by assenting to the cancellation of the claim and by amending it, the applicant has abandoned it as it stood. Certainly it cannot be necessary to this conclusion that he shall amend the cancelled claim, when he has already filed a claim which contains the necessary differentia.

Keith, 116 F.2d at 48. That this is literally a matter of hornbook law is reflected in the Chisum treatise. Summarizing the consistent case law on the issue, Professor Chisum reports that estoppel arises "when a broad claim is cancelled after rejection and a narrower claim is retained without amendment." 5A Chisum on Patents, § 18.05[2][a][ii] (citing decisions).

Honeywell's petition purports to offer decisions that have reached the opposite result, but its efforts are off the mark. Not one of the four cases Honeywell cites provides valid support for its argument. First, Honeywell cites an ***unpublished, non-precedential*** decision, *Vermeer Manufacturing Co. v. Charles Machine Works, Inc.*, 251 F.3d 168 (Fed. Cir. 2000). As Honeywell must know, because the citation it gives to *Vermeer* so states, Federal Circuit rules forbid attempts to cite such cases as precedent. 251 F.3d at 166 (Preface to table of unpublished cases, including *Vermeer*, stating that unpublished cases "are not citable as precedent"). Moreover, *Vermeer* does not address the fact that is key to estoppel here—cancellation of the rejected, broader

independent claim, and replacement of it with a narrower dependent claim. Notably, Chief Judge Mayer and Judge Schall formed the majority of the panel in *Vermeer*, and both joined the majority decision here.

Honeywell also cites *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354 (Fed. Cir. 2001). But Chief Judge Mayer, who authored both *Bose* and *Ranbaxy*, expressly stated that *Bose* is ***not*** precedent for the question here. He wrote in *Ranbaxy*:

> [In *Bose*], we addressed whether the addition of an inherent element to a claim was a narrowing amendment invoking the absolute bar of our *en banc Festo* decision and answered in the negative. We did ***not*** squarely address the effect that rewriting a dependent claim into independent form may have on prosecution history estoppel.

350 F.3d at 1240 (emphasis supplied). And again, Chief Judge Mayer and Judge Bryson, who formed the majority of the panel in *Bose*, joined the majority decision here.

Honeywell next cites *Insta-Foam Products, Inc. v. Universal Foam Systems, Inc.*, 906 F.2d 698 (Fed. Cir. 1990). That case involved a patent claim for a dispensing gun that included a limitation specifying a connection between the "plunger" and the "trigger." *Id.* at 700. The issue was whether this limitation could be satisfied by equivalence where the accused device's plunger and trigger were separable. *Id.* at 700-01. During prosecution of the patent, the applicant had cancelled an independent claim and replaced it with a previously-dependent claim. *Id.* at 703. But the limitation at issue—which specified the connection between the plunger and the trigger—had ***not*** been present

in the dependent claim. Rather, it had been in the original independent claim. The *Insta-Foam* court therefore held that no estoppel applied to this limitation: "For the reason that the allowed claim contains the same limitation regarding the connection between the trigger and plunger means as did the abandoned claim, the patent applicant did not disclaim anything relating to the manner by which the plunger and trigger are connected." *Id.* at 703.

Here, by contrast, the limitation at issue was ***not*** present in the abandoned claim. In the illustration in which a patent applicant cancels an original independent claim that had limitations A, B and C and replaces it with a previously-dependent claim that adds limitation D, the limitation at issue in *Insta-Foam* was limitation A, B or C—and ***not*** limitation D. But here, the inlet guide vane limitation ***was*** limitation D; that is, it was the limitation Honeywell relied upon to narrow the claimed subject matter when it cancelled the original independent claim that lacked the limitation and replaced that claim with a previously-dependent claim that included the limitation.

Insta-Foam expressly makes this distinction. It stated that estoppel ***would*** arise as to the limitation that had been present in the dependent claim—which specified an external biasing means—and had been used to distinguish the prior art:

> Although the amendment of application claim 9 [the independent claim that was rewritten to include the limitation from the previously-dependent claim] to avoid the Johnson patent ***was a disclaimer*** of any device containing an internal biasing means, *i.e.*, one contained within the fluid passages of the handle means, this disclaimer does not preclude

> infringement in this case where the accused device embodies an external biasing means that is an equivalent to the biasing means defined in the claim.

Id. at 704 n. 3 (emphasis supplied). Thus, contrary to Honeywell's argument, *Insta-Foam* demonstrates that estoppel ***would*** apply to the limitation that had been present in the previously-dependent claim, as was the inlet guide vane limitation here.[3]

Finally, Honeywell inexplicably cites *Bloom Engineering Co. v. North American Manufacturing Co.*, 129 F.3d 1247 (Fed. Cir. 1997). But that decision concerns intervening rights after a reexamination, which involves a different set of rules and rationales than prosecution history estoppel. *Id.* at 1249-50. Moreover, a majority of the panel in *Bloom*, Chief Judge Mayer and Judge Schall, joined the 11 to one majority opinion here. They obviously found no conflict between *Bloom* and *Honeywell*.

In sum, Honeywell can find no decision that has addressed the question here and held that estoppel does not arise. Nor does the lone dissenter below, Judge Newman, identify any such holding. To the contrary, the Federal Circuit's decision is consistent with every precedent that has addressed the question presented.

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[3] As confirmation of the point, *Insta-Foam* is included in the list of "flexible bar" rulings in Judge Michel's opinion concurring and dissenting in part in the Federal Circuit's first en banc decision in *Festo*. *See Festo*, 234 F.3d at 614. If no estoppel had arisen from the prosecution in *Insta-Foam*, there would be no need to employ the flexible bar test to compare the scope of the estoppel to the alleged equivalent.

III. Honeywell's Arguments About The Decision's Purported Effect On Patent Prosecution Are Wrong

Honeywell offers a variety of arguments that the decision here is contrary to statute and that it will damage patent prosecution. All are unfounded. Further, it should be noted at the outset that Honeywell's arguments about the purported effects of the decision here, set forth in Section II of its petition, are directed to the second of its two questions presented. But this second question presented is improper, because it goes well beyond the specific issue addressed and decided by the Federal Circuit.

A. The Decision Poses No Conflict With The Statutory Definition Of A Dependent Claim

Contrary to Honeywell's argument, there is no conflict between the consistent line of authority discussed above and the uncontroversial principle reflected in 35 U.S.C. § 112, paragraph 4, that a dependent claim includes all the elements of its antecedent independent claim. The narrowing of claim scope that gives rise to estoppel in the circumstances here comes not merely from rewriting a dependent claim into independent form, but from ***surrendering*** the original independent claim by cancelling it. By statute, a dependent claim must contain a reference to a claim previously set forth "and then specify a further limitation of the subject matter claimed." 35 U.S.C. § 112, ¶4 (emphasis supplied). Hence, a patent applicant knows he is surrendering claim scope when he cancels an original independent claim with elements A, B and C and settles instead for a previously-dependent claim with elements A, B, C and D. In the words of the statute, he is accepting a claim with a "further limitation of the subject matter claimed."

Nor does the decision here add any new burdens to patent prosecution. An applicant whose original independent claim is rejected has the same choices as always: contest the rejection, or gain allowance by agreeing to narrow his claim scope. If he elects to narrow claim scope, cancelling the rejected independent claim and replacing it with a narrower previously-dependent claim is merely one of the ways he may do so. That doing so gives rise to presumptive estoppel places no special burden or penalty on the use of dependent claims. Estoppel arises not because the applicant included a dependent claim in his application (nor would it have mattered if he had called the narrower claim an independent claim). Estoppel arises because the applicant agreed to cancel his original broad independent claim and accept a narrower claim instead, with the additional limitation from the previously-dependent claim clearly defining the scope of subject matter surrendered.

And of course when presumptive estoppel does apply, because the applicant has chosen to narrow his claim scope to gain allowance, the patentee will always have the opportunity to rebut the presumption of estoppel under the standards set forth in *Festo*. *See Festo*, 535 U.S. at 740-41.

B. The Decision Does Not Produce A "New Form Of Estoppel"

Honeywell's contention that the decision here produces a "new form of estoppel" (Pet. at 18) is plainly wrong in light of the decision's adherence to the core principles of prosecution history estoppel, to the precedents that have specifically addressed the question presented, and to the guidance of this Court in *Festo*. Honeywell maintains it is improper to base estoppel on the "cancellation of broader

claims" and their replacement by "narrower claims." *Id.* But this simply ignores the fact that, as this Court emphasized in *Festo*, "[e]stoppel is a 'rule of patent construction' that ensures that claims are interpreted by reference to those 'that have been ***cancelled or rejected***.'" *Festo*, 535 U.S. at 733 (quoting *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940)) (emphasis supplied). The purpose of estoppel is to prevent a patentee from attempting to recapture "subject matter surrendered as a condition of receiving the patent." *Festo*, 535 U.S. at 734. To determine whether an applicant has surrendered subject matter manifestly requires a comparison of the broader claim the applicant cancelled and the narrower claim he accepted instead.

Honeywell next maintains that there should be no estoppel here because the inlet guide vane limitation was not itself amended or rejected. Pet. at 19. But there never has been any such requirement. In *Festo*, as noted, the magnetizable sleeve and sealing rings limitations at issue had been present in original dependent claims and were never themselves "amended or rejected." Rather, the applicant simply cancelled independent claims that lacked these limitations and replaced them with new independent claims that included these limitations. *See Festo*, 234 F.3d at 583, 588.

The same is true in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). The patent there concerned an ultrafiltration process for purifying dye. *Id.* at 22. During prosecution, the applicant narrowed the claim by introducing a limitation that specified the pH levels at which the process was conducted. *Id.* This limitation was never "amended or rejected," to use

Honeywell's words. This Court held that the estoppel would apply to this pH limitation, stating that "application of the doctrine of equivalents as to that element" would be barred unless the applicant could show a reason for the amendment sufficient to avoid estoppel. *Id.* at 33.

Honeywell's argument merely repeats that of Judge Newman in her solo dissent, that no estoppel should arise because the limitation at issue was "never rejected [and] never amended." Pet. at 19, quoting *Honeywell*, 370 F.3d at 1150, App. 34a (Newman, J., dissenting). But this itself simply repeats the same argument Judge Newman made in *Festo*. There, she stated that the limitations at issue "were not amended during prosecution" and that in the issued claims these limitations were "not more narrowly [claimed] than in original dependent claims 4 and 8." *Festo*, 234 F.3d at 637, 631 (Newman, J., dissenting). Arguing that it was "legally incorrect" to hold that estoppel arises in these circumstances, Judge Newman complained: "As illustrated by the Carroll and Stoll patents in suit, equivalents are now held forfeited whether or not the claimed element itself was amended, or even discussed, during prosecution." *Id.* at 631. Yet of course this Court ***disagreed*** with this argument and held that the presumption of estoppel did arise on these facts. *See Festo*, 535 U.S. at 736-37.[4]

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[4] The first question presented in *Festo* concerned "the kinds of amendments that may give rise to estoppel," 535 U.S. at 735, and on that question this Court agreed with the Federal Circuit majority decision. *Id.* at 735-37. It was on the second question presented, whether there should be a "complete bar" when estoppel arises, that the Court disagreed with the Federal Circuit and adopted instead a presumptive bar. *Id.* at 737-41.

C. The Decision Does Not Create "Unbounded Estoppel"

There is nothing "unbounded" about the Federal Circuit's holding that presumptive estoppel applies to the inlet guide vane limitation. As the Federal Circuit explained, this limitation defined the scope of surrendered subject matter when Honeywell cancelled the original independent claim that lacked the inlet guide vane limitation and replaced it with the previously-dependent claim that included it. *Honeywell*, 370 F.3d at 1144, App. 22a.

This is no different from the multitude of decisions that have applied estoppel to a limitation when the applicant uses the limitation to narrow his claim scope and gain allowance. *Warner-Jenkinson* is just one example. The original claim there said nothing about the pH level at which the process for purifying dye was conducted. *Warner-Jenkinson*, 520 U.S. at 22. The applicant later narrowed the claim by introducing a limitation that specified pH levels. *Id.* As noted, this Court held that the estoppel would apply to this pH limitation, unless the applicant could show a reason for the amendment sufficient to avoid estoppel. *Id.* at 32-34. It is no more "unbounded" to apply presumptive estoppel to the inlet guide vane limitation here than to apply estoppel to the pH limitation in *Warner-Jenkinson*. So too in *Festo*, this Court held that presumptive estoppel applied to the magnetizable sleeve limitation and sealing rings limitation, both of which had been present in original dependent claims before being incorporated into an independent claim. 535 U.S. at 736-37; *see also Festo*, 234 F.3d at 582-83, 588.

D. The Decision Does Not "Disrupt Settled Expectations"

Honeywell is just as off-base in its final argument, that the Federal Circuit's decision somehow disrupts settled expectations. Pet. at 22. In light of the consistent authority discussed above, the holding here cannot be considered at all surprising to anyone conversant in this area.

And the Federal Circuit's decision plainly is fair. When a patent applicant cancels a rejected independent claim and replaces it by rewriting a dependent claim into independent form, he knows he is narrowing his claim scope. The applicant would have obtained the identical claim if he had rewritten the independent claim to include an additional limitation from the dependent claim and then cancelled the dependent claim. In both cases, a broader claim was surrendered and a narrower claim accepted. The cases should be treated the same and in both the additional limitation must be considered a narrowing of claim scope. To argue for different outcomes in these two scenarios would be illogical and would exalt form over substance. The Federal Circuit was right to reject such a false distinction.